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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,956	03/31/2004	Christine Meunier	237565US0	4881

22850 7590 07/16/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FRAZIER, BARBARA S

ART UNIT	PAPER NUMBER
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1609

NOTIFICATION DATE	DELIVERY MODE
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07/16/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/812,956

Applicant(s)

MEUNIER, CHRISTINE

Examiner

Barbara Frazier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15, 17-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a composition, classified in class 424, subclass 70.12. (If Group I is elected, an election of species is required – see paragraph 5.)
 - II. Claim 23, drawn to a process for treating the skin, the hair, the nails, the scalp and/or mucous membranes, classified in class 514, subclass 63. (If Group II is elected, two election of species are required – see paragraphs 5 and 12.)

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process such as a cleaning composition. The use of glycerides, alcohols, and polysiloxanes as cleaning agents is well known to those of ordinary skill in the art.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

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4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

5. **For either group elected, the following election is required:**

6. Claims 1-15 and 17-23 are generic to the following disclosed patentably distinct species:
a composition according to claim 1 wherein the composition:

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A) comprises an exact choice for each of the components (a) – (d) listed in claim 1 and further comprises at least one cyclomethicone (see claims 7-11);

B) comprises an exact choice for each of the components (a) - (d) listed in claim 1 and further comprises at least one lipolytic active agent (see claims 18-21) **(please note: if Specie B) is elected, a further election is required – see paragraph 7);**

C) comprises an exact choice for each of the components (a) - (d) listed in claim 1 and further comprises at least one active agent selected from the list in claim 22 **(please note: if Specie C) is elected, a further election is required – see paragraph 9);** or

D) comprises an exact choice for each of the components (a) - (d) listed in claim 1 and does not further comprise A), B), or C).

For clarification, Applicants are first required to select an exact choice for each of components (a) – (d) listed in claim 1, and then proceed to choose A), B), C), or D) using the then elected (a) – (d) specie choices.

The species are independent or distinct because the myriad of choices available for each of components (a) - (d) in the composition of claim 1 vary significantly in structure and properties, such that the exact combinations of components (a) - (d) will impart significantly and mutually distinct properties to each of the claimed compositions. Furthermore, the addition (or nonaddition) of each of the additional species listed in Specie A), B), or C) also vary significantly in structure and properties (for example, a cyclomethicone has a different structure and set of properties than the lipolytic active agent caffeine), thus imparting mutually distinct properties to the resultant compositions. Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species**, even though this requirement is traversed. Applicant is directed to

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Compositions 1-18, found on pages 21-32 of the specification, as examples of a single disclosed species. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is cautioned that the election of a specific combination not specifically disclosed as filed may be considered NEW MATTER.

7. If Specie B) is elected, the following further election is required:

8. Claims 1 and 18-21 are generic to the following disclosed patentably distinct species: the compositions of claim 18, each specie being directed to an exact choice for each of the components (a)-(d) (see paragraph 6, above) and an exact choice for the lipolytic active agent of claim 18 (see claim 19 for examples). The species are independent or distinct because the lipolytic active agents of claim 18 vary significantly in structure and properties (for example, caffeine, commonly used as a stimulant, has a different structure and set of properties than extracts of orthosiphon, commonly used for kidney stones and nephritis), thus imparting mutually distinct properties to the resultant compositions. Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species**, even though this requirement is traversed. Applicant is directed to Compositions 1-18, found on pages 21-32 of the specification, as examples of a

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single disclosed species. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is cautioned that the election of a specific combination not specifically disclosed as filed may be considered NEW MATTER.

9. If Specie C) is elected, the following further election is required:

10. Claims 1 and 22 are generic to the following disclosed patentably distinct species: the compositions of claim 22, each specie being directed to an exact choice for each of the components (a)-(d) (see paragraph 6, above) and exact choice for the active agent of claim 22. The species are independent or distinct because the active agent of claim 22 vary significantly in structure and properties (for example, a desquamating agent has a different set of properties than a muscle relaxant), thus imparting mutually distinct properties to the resultant compositions. Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species**, even though this requirement is traversed. Applicant is directed to Compositions 1-18, found on pages 21-32 of the specification, as examples of a single disclosed species. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this

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requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is cautioned that the election of a specific combination not specifically disclosed as filed may be considered NEW MATTER.

11. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

12. If Group II is elected, the following election is also required:

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13. Claim 23 is generic to the following disclosed patentably distinct species: the process for treating :

- i) the hair,
- ii) the nails,
- iii) the scalp, or
- iv) mucous membranes

comprising applying the elected composition above. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including

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any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

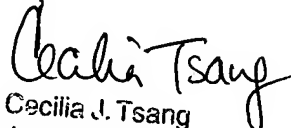
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Frazier whose telephone number is (571)270-3496. The examiner can normally be reached on Monday - Thursday from 8 a.m. to 4 p.m.. The examiner can also be reached on alternate Fridays

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BSF


Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600